

ESTTA Tracking number: **ESTTA559676**Filing date: **09/16/2013**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

**Petitioner Information**

|         |   |             |          |
|---------|---|-------------|----------|
| Name    | G6 Hospitality IP LLC   |             |          |
| Entity  | Limited Liability Company   | Citizenship | Delaware |
| Address | 4001 International Parkway<br>Carrollton, TX 75007<br>UNITED STATES |             |          |

|                      |  |
|----------------------|--|
| Attorney information | Cory M. Amron<br>Vorys, Sater, Seymour & Pease LLP<br>52 East Gay Street<br>Columbus, OH 43215<br>UNITED STATES<br>tmcucio@vorys.com, iplaw@vorys.com, cmamron@vorys.com,<br>jcmakley@vorys.com Phone:202-467-8800 |
|----------------------|--|

**Registration Subject to Cancellation**

|                                |   |                                 |            |
|--------------------------------|---|---------------------------------|------------|
| Registration No                | 3505545   | Registration date               | 09/23/2008 |
| International Registration No. | NONE  | International Registration Date | NONE       |
| Registrant                     | Motel One GmbH<br>Theatinerstrasse 16 80333 MÃ¼nchen<br><br>GERMANY |                                 |            |

**Goods/Services Subject to Cancellation**

|   |
|---|
| Class 035.<br>All goods and services in the class are cancelled, namely: Professional business consulting services for catering and accommodation enterprises, including technical assistance in the establishment and operation of catering and accommodation businesses; consulting services for business management, planning and supervision of catering and accommodation enterprises; franchising of catering enterprises, namely, offering business know-how concerning the establishment and/or operation of catering and accommodation enterprises |
| Class 042.<br>All goods and services in the class are cancelled, namely: Providing temporary accommodation; catering services; making reservations of temporary lodging for others; technical consulting, namely, computer consultation in connection with catering and temporary accommodation enterprises   |

**Grounds for Cancellation**

|                                      |  |
|--------------------------------------|--|
| Abandonment                          | Trademark Act section 14   |
| Priority and likelihood of confusion | Trademark Act section 2(d)   |
| Other                                | Petitioner asserts that, at the time of filing application Serial No. 79/044,672, the Registrant |

|  |  |
|--|--|
|  | lacked the requisite bona fide intent to use the mark with the listed services in commerce in the United States. |
|--|--|

## Marks Cited by Petitioner as Basis for Cancellation

|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 1816233  | Application Date      | 12/11/1991 |
| Registration Date     | 01/11/1994   | Foreign Priority Date | NONE       |
| Word Mark             | MOTEL 6  |                       |            |
| Design Mark           |  |                       |            |
| Description of Mark   | NONE   |                       |            |
| Goods/Services        | Class 042. First use: First Use: 1961/07/01 First Use In Commerce: 1965/06/15 motel services |                       |            |

|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 822563   | Application Date      | 10/12/1965 |
| Registration Date     | 01/17/1967   | Foreign Priority Date | NONE       |
| Word Mark             | MOTEL 6  |                       |            |
| Design Mark           |  |                       |            |
| Description of Mark   | NONE   |                       |            |
| Goods/Services        | Class U100 (International Class 042). First use: First Use: 1961/07/01 First Use In Commerce: 1965/06/15<br>MOTEL SERVICES |                       |            |

|                       |   |                       |            |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 1589489   | Application Date      | 06/07/1989 |
| Registration Date     | 03/27/1990  | Foreign Priority Date | NONE       |
| Word Mark             | MOTEL 6   |                       |            |
| Design Mark           |   |                       |            |
| Description of Mark   | NONE  |                       |            |
| Goods/Services        | Class 042. First use: First Use: 1961/07/01 First Use In Commerce: 1965/06/15<br>MOTEL SERVICES |                       |            |

|                       |   |                       |            |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 1788512   | Application Date      | 05/08/1990 |
| Registration Date     | 08/17/1993  | Foreign Priority Date | NONE       |
| Word Mark             | MOTEL 6   |                       |            |
| Design Mark           |   |                       |            |
| Description of Mark   | NONE  |                       |            |
| Goods/Services        | Class 041. First use: First Use: 1961/07/01 First Use In Commerce: 1965/06/15 |                       |            |

|  |                |  |  |
|--|----------------|--|--|
|  | motel services |  |  |
|--|----------------|--|--|

|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 2198435  | Application Date      | 10/14/1997 |
| Registration Date     | 10/20/1998   | Foreign Priority Date | NONE       |
| Word Mark             | MOTEL 6  |                       |            |
| Design Mark           |  |                       |            |
| Description of Mark   | NONE   |                       |            |
| Goods/Services        | Class 042. First use: First Use: 1997/05/12 First Use In Commerce: 1997/05/12 motel services |                       |            |

|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 2264831  | Application Date      | 06/04/1998 |
| Registration Date     | 07/27/1999   | Foreign Priority Date | NONE       |
| Word Mark             | MOTEL 6  |                       |            |
| Design Mark           |  |                       |            |
| Description of Mark   | NONE   |                       |            |
| Goods/Services        | Class 042. First use: First Use: 1997/05/12 First Use In Commerce: 1997/05/12 motel services |                       |            |

|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 3660463  | Application Date      | 12/02/2008 |
| Registration Date     | 07/28/2009   | Foreign Priority Date | NONE       |
| Word Mark             | MOTEL 6  |                       |            |
| Design Mark           |  |                       |            |
| Description of Mark   | The mark consists of the word "motel" running vertically up the left side of the image next to the number "6". |                       |            |
| Goods/Services        | Class 043. First use: First Use: 2008/08/22 First Use In Commerce: 2008/08/22 Hotel and motel services         |                       |            |

|             |  |
|-------------|--|
| Attachments | Petition to Cancel- MOTEL ONE (3505545).pdf(275071 bytes ) |
|-------------|--|

## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

|           |                    |
|-----------|--------------------|
| Signature | /tmc/              |
| Name      | Tanya Marie Curcio |
| Date      | 09/16/2013         |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

G6 HOSPITALITY IP LLC

Petitioner,

v.

MOTEL ONE GMBH,

Registrant.

Cancellation No. \_\_\_\_\_

Trademark Registration No. 3,505,545

Mark: MOTEL ONE (& Design)

Date Registered: September 23, 2008

**PETITION TO CANCEL**

G6 Hospitality IP LLC (“Petitioner”) is a Delaware limited liability company with a business address at 4001 International Parkway, Carrollton, Texas 75007. To the best of Petitioner’s knowledge, the owner of U.S. Trademark Registration No. 3,505,545 (the “Registration”) for the mark MOTEL ONE (& Design) (“MOTEL ONE Mark”) is Motel One GmbH, a German company (“Registrant”) with a business address of Theatinerstrasse 16, D-80333 Munchen, Germany. Petitioner believes that it is damaged by the Registration and petitions to cancel it as set forth below.

## **BACKGROUND**

1. Since at least as early as January 1965 Petitioner and its predecessors in interest have used, and still presently use, the mark MOTEL 6 alone or with design elements (collectively, “MOTEL 6 Mark(s)”) in connection with motel services and hotel services and making reservations for the same (“Petitioner’s Services”) in the United States.

2. Petitioners’ MOTEL 6 Mark is a household name with respect to Petitioner’s Services and the hospitality industry.

3. Petitioner provides Petitioner’s Services in the United States and Canada and currently has approximately 1,100 locations with more than 105,000 rooms.

4. *Advertising Age* magazine has recognized Petitioner’s *We ’ll Leave the Light on for You* advertising campaign, used in connection with Petitioner’s Services, as one of the top advertising campaigns in the last 100 years and Petitioner was the only lodging or temporary accommodations provider to earn this distinction.

5. Since at least as early as May 4, 2000, Petitioner’s customers have been able to make reservations for Petitioner’s Services and Petitioner’s franchisees’ temporary accommodation facilities using Petitioner’s website. Prior to that time and to date, Petitioner’s customers have been able to make reservations for Petitioner’s Services and Petitioner’s franchisees’ temporary accommodation facilities using the telephone.

6. Petitioner is the owner of several incontestable trademark registrations for the MOTEL 6 Marks including Reg. Nos., 1,816,233; 0,822,563; 1,589,489; 1,788,512; 2,198,435; 2,264,831 for use in connection with “motel services” and Petitioner is also the owner of trademark registration No. 3,660,463 for the MOTEL 6 Mark for use in connection with “hotel and motel services” (collectively, “Petitioner’s Registrations”).

7. Petitioner has invested substantial time, effort, and money in promoting Petitioner's Services provided in connection with MOTEL 6 Marks.

8. The MOTEL 6 Marks are recognized as exclusively identifying Petitioner's Services and embody the goodwill and reputation that Petitioner has developed by continuously using the MOTEL 6 Marks over almost fifty (50) years.

9. On July 10, 2007 ("Registrant's Filing Date"), Registrant filed an application, Serial Number 79/044,672, ("Application") with the U.S. Patent and Trademark Office ("USPTO") for the MOTEL ONE Mark, for use in connection with "*professional business consulting services for catering and accommodation enterprises, including technical assistance in the establishment and operation of catering and accommodation businesses; consulting services for business management, planning and supervision of catering and accommodation enterprises; franchising of catering enterprises, namely, offering business know-how concerning the establishment and/or operation of catering and accommodation enterprises*" in international class 35 and "*providing temporary accommodation; catering services; making reservations of temporary lodging for others; technical consulting, namely, computer consultation in connection with catering and temporary accommodation enterprises*" in international class 42 ("Registrant's Services").

10. The Application that resulted in the Registration was filed under Section 66(a) of the Trademark Act, 15 U.S.C. §1141(f), wherein the Registrant declared that it possessed a bona fide intent to use the MOTEL ONE Mark in connection with all of the Registrant's Services in commerce in the United States.

11. The Registration issued on September 23, 2008.

12. The Registration is fewer than five years old and is therefore subject to cancellation under Section 14(1) of the Lanham Act, 15 U.S.C. §1064.

## **COUNT I**

### **ABANDONMENT**

13. Petitioner re-alleges and incorporates by reference paragraphs 1 through 12.

14. Upon information and belief, Registrant has never used and is not currently using the MOTEL ONE Mark in commerce in the United States.

15. Upon information and belief, Registrant has never operated a hotel, motel or any temporary accommodations or lodging facility (“Hotel Services”) in the United States.

16. Upon information and belief, Registrant has never provided the service of making reservations of temporary lodging for others (“Reservation Services”) in the United States.

17. Upon information and belief, Registrant has never provided: professional business consulting services for catering and accommodation enterprises, including technical assistance in the establishment and operation of catering and accommodation businesses; consulting services for business management, planning and supervision of catering and accommodation enterprises; franchised catering enterprises, namely, offering business know-how concerning the establishment and/or operation of catering and accommodation enterprises, technical consulting services, namely, computer consultation in connection with catering and temporary accommodation enterprises (“Consulting Services”) in the United States.

18. Upon information and belief, Registrant has never provided catering services (“Catering Services”) in the United States.

19. Upon information and belief, Registrant has not used the MOTEL ONE Mark in commerce in the United States in connection with any of Registrant’s Services for at least the last three years.

20. Upon information and belief, Registrant has no intent to commence or to resume use of the MOTEL ONE Mark in commerce in the United States.

21. Upon information and belief, the MOTEL ONE Mark has been abandoned due to nonuse.

## **COUNT II**

### **LACK OF BONA FIDE INTENT TO USE**

22. Petitioner re-alleges and incorporates by reference paragraphs 1 through 21.

23. Upon information and belief, as of the filing date of the Application the Registrant did not have a bona fide intent to use the MOTEL ONE Mark in commerce in the United States in connection with Registrant's Services.

## **COUNT III**

### **LIKELIHOOD OF CONFUSION**

24. Petitioner re-alleges and incorporates by reference paragraphs 1 through 12.

25. Petitioner and its predecessors-in-interest have used the MOTEL 6 Mark in connection with Petitioner's Services for forty-two (42) years before Registrant's Filing Date.

26. Petitioner and its predecessors-in-interest have used the MOTEL 6 Mark in connection with making reservations for Petitioner's Services and Petitioner's franchisees' temporary accommodation facilities prior to any date that Registrant can rely on.

27. Both the MOTEL ONE Mark and MOTEL 6 Marks begin with the word "MOTEL."

28. Both the MOTEL ONE Mark and MOTEL 6 Marks contain a single digit number directly after the word "MOTEL."

29. The MOTEL ONE Mark is confusingly similar to the MOTEL 6 Marks.

30. Registrant's Hotel Services are identical to Petitioner's Services.



31. Registrant's Reservation Services are identical to Petitioner's Services.
32. Registrant's Catering Services are very closely related to Petitioner's Services.
33. Registrant's Consulting Services are very closely related to Petitioner's Services.
34. The Registration damages Petitioner by interfering with Petitioner's exclusive right to use and enforce the MOTEL 6 Marks in connection with the Petitioner's Services.
35. Because the MOTEL ONE Mark and MOTEL 6 Marks are confusingly similar and the Registrant's Services and Petitioner's Services are identical or are very closely related, the MOTEL ONE Mark is likely to cause confusion, cause mistake or deceive the public, and cause the public to believe, incorrectly, that Registrant's Services emanate from, are authorized or endorsed by, or are otherwise connected with Petitioner in violation of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

\* \* \*


WHEREFORE, Petitioner prays that The Trademark Trial and Appeal Board sustain this Petition and cancel Registration No. 3,505,545 for the MOTEL ONE Mark.

The required fee accompanies this Petition to Cancel. Please charge any additional fees to Deposit Account No. 22-0585.

Please recognize Cory M. Amron, William H. Oldach III, Christopher M. Ott, all members of the bar of the District of Columbia, and Tanya Marie Curcio, a member of the bar of the State of New York, and all of the firm of Vorys, Sater, Seymour and Pease, LLP, as Petitioner's attorneys to prosecute this Petition to Cancel.

Respectfully submitted,

Date: September 16, 2013

  
\_\_\_\_\_  
Tanya Marie Curcio  
Cory M. Amron  
William H. Oldach III

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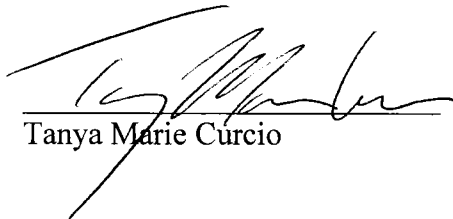
## **CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing Petition to Cancel has been served on Motel One GmbH by mailing said copy on this 16th day of September 2013, via Federal Express International, postage prepaid to:

President  
Motel One GmbH  
Theatinerstrasse 16 80333 München  
Federal Republic of Germany

I hereby certify that a true and complete copy of the foregoing Petition to Cancel has been served on James H. Johnson Jr. Esq. by mailing said copy on this 16th day of September 2013, via First Class Mail, postage prepaid to:

James H. Johnson Jr.  
Sutherland Asbill & Brennan LLP  
999 Peachtree Street NE  
Atlanta, GA 30309-3996  
United States



Tanya Marie Curcio